

REMARKS

Upon entry of this amendment, independent claim 1 with dependent claims 2-15 and independent claim 16 will be present in the application.

Claims 1 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. 6,379,094 (Porat), the Office Action contending that "Porat discloses a board feed (2), a covering material feed (6), a glue spreading roller (26), a covering material cylinder (22), a folding and pressing apparatus (30), a delivery apparatus (32), and a drive apparatus (40)." The Applicants respectfully submit that the Porat reference does not disclose all of the elements alleged in the Office Action. Specifically, item 2 is board panels (Col. 4, line 30), not a board feed; item 6 is cover material (Col. 4, line 32), not a covering material feed; item 26 is merely a first pressure nip (Col. 4, line 35), a glue spreading roller is not used in Porat because the cover material is pre-glued (Col. 4, line 25); and item 22 is an infeed table assembly (Col. 4, line 54), not a covering material cylinder. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention." Transco Products Inc. v. Performance Contracting Inc., 23 USPQ2d 1691, 1694 (N.D. Ill. 1992), see also Hybritech Inc. v. Monoclonal Antibodies, Inc., 213 USPQ 81 (Fed. Cir. 1986) and Stoller v. Ford Motor Co., 18 USPQ2d 1545, 1547 (Fed. Cir. 1991). Clearly, the Office Action does not show how the Porat reference discloses all of the elements recited in claim 1.

In addition, claim 1 recites "a drive apparatus driving the covering material feed, the board feed, the covering material cylinder, and the folding and pressing apparatus, at least the covering material feed, the board feed and the folding and pressing apparatus being independently drivable from one another." The Office Action cites the table drive motor 40, of the Porat reference as being equivalent to the drive apparatus of claim 1. However, the table drive motor 40 functions only to move infeed table assembly 22 "to and fro along the pair of shafts 36". (Col. 5, lines 13-14) The Porat table drive motor 40 does not drive "the covering material feed, the board feed, the covering material cylinder, and the folding and pressing apparatus", as recited in claim 1.

Further, the Office Action contends that "the board feed, covering material feed, and the folding and pressing apparatus are inherently capable of being driven independently

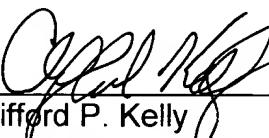
and the covering material feed and the covering material cylinder are inherently capable of being adjusted electronically." However, given the requirements for inherency, this is simply not true. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference ... Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Roberson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), as quoted in MPEP § 2112. It cannot be shown that the covering material feed, the board feed and the folding and pressing apparatus are necessarily independently drivable from one another because "[i]n the previously known apparatuses the essential functions, such as the board feed, covering material feed, covering material cylinder and folding and pressing apparatus, are coupled directly to one another by a common drive." (Page 2, lines 1-4)

For all of the above stated reasons, the rejection under 35 U.S.C. § 102(b) may not be maintained.

The Office Action indicates that claims 2-12, 14 and 15 are allowable. New claim 16 represents claim 2 written in independent form, with the exception that claim 16 does not explicitly recite that at least the covering material feed, the board feed and the folding and pressing apparatus are independently drivable from one another.

In view of the above-directed amendments and the proceeding remarks, prompt and favorable reconsideration is respectfully requested.

Respectfully submitted,
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